

## **REMARKS**

*Please note that the claim amendments provided above consist solely of modifying the language of the existing claims for the purpose of clarifying the language of the limitations of those claims and of further limiting the claims consistent with one or more of the dependent claims. Consequently, no new matter has been added, and no new search is required.*

This application is believed to be in condition for allowance because the claims, as amended, are non-obvious and patentable over the cited references. The following paragraphs provide the justification for this belief. In view of the following reasonings for allowance, the Applicants hereby respectfully request further examination and reconsideration of the subject patent application.

### **1.0 Rejections Under 35 U.S.C. §102(b):**

In the Office Action of October 27, 2003, claims 48-53 were rejected under 35 U.S.C. §102(b), as being anticipated by Novell GroupWise 5.5 as supported by "GroupWise User's Guide for Windows 95/98/NT," (hereinafter "**GroupWise**"), and Novell articles entitled "GroupWise 5.x & 6.x" and "MAPI."

A rejection under 35 U.S.C. §102(b) requires that the Applicants' invention was described in a printed publication more than one year prior to the date of application for patent in the United States. To establish that a patent describes the Applicants' invention, all of the claimed elements of an Applicants' invention must be considered, especially where they are missing from the prior art. If a claimed element is not taught in the referenced patent, then a rejection under 35 U.S.C. §102(b) is not proper, as the Applicants' invention can be shown to be patentably distinct from the cited reference.

## 1.1 Rejection of Claim 48:

The Office Action rejected independent claim 48 under 35 U.S.C. §102(b) based on the rationale that the **GroupWise** reference discloses each of the elements of the Applicants' claimed "...method for automatically generating a dynamic list of entries containing contact information..." However, the Applicants respectfully request further consideration of the rejection of claim 48, as amended, for the reasons discussed below.

In particular, the Office Action rejected claim 48 based on the rationale that, among other things, **GroupWise** teaches capturing addresses and contact information from emails and database files. In response, Applicants have amended independent claim 48 to further limit the file types included in the data store that is scanned for extracting contact information. Specifically, claim 48 now recites "scanning any of a plurality of file types in a data store containing electronic files including at least one of ***word processor files, spreadsheet files, and presentation files.***"

As discussed in the Applicants previous response, neither the GroupWise nor MAPI references disclose scanning spreadsheet files and extracting contact information from such files. Similarly, none of the cited references disclose scanning either word processor files or presentation files and extracting contact information from such files. One clear advantage over the cited references is that the claimed invention is capable of extracting contact from a much broader range of sources than any of the cited references. Further, these sources provide a resource for extracting contact information that has not been previously tapped by conventional address resolution systems.

Consequently, in view of the preceding discussion, it is clear that the present invention, as claimed by independent claim 48, has elements not taught in the **GroupWise** reference, as supported by the Novell articles entitled "GroupWise 5.x & 6.x" and "MAPI." Consequently, the rejection of claim 48 under 35 U.S.C. §102(b) is no longer proper. Therefore, the Applicants respectfully request reconsideration of the

rejection of claims 48-53 under 35 U.S.C. §102(b) in view of the claim language of claim 48 which includes the following novel language:

A method for automatically generating a dynamic list of entries containing contact information comprising:

scanning any of a plurality of file types in a data store containing electronic files including ***at least one of word processor files, spreadsheet files, and presentation files***;

extracting contact information from any of the scanned files; and  
populating the list with the information extracted from the scanned files. (emphasis added)

## **2.0 Rejections Under 35 U.S.C. §103(a):**

In the Office Action of May 8, 2003, claims 1-3, 5-17, 21-36, 38-43 and 45-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over the ***GroupWise*** in view of Teare, et al, ("***Teare***," U.S. Patent No. 6,151,624).

In order to deem the Applicants' claimed invention unpatentable under 35 U.S.C. §103(a), a prima facie showing of obviousness must be made. However, as fully explained by the M.P.E.P. Section 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, ***to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference (or references when combined) must teach or suggest all the claim limitations***.

Further, in order to make a prima facie showing of obviousness under 35 U.S.C. 103(a), all of the claimed elements of an Applicants' invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in

the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

## **2.1 Rejection of Claims 1 and 32:**

With respect to independent claims 1 and 32, the Office Action rejected these claims under 35 U.S.C. 103(a) based, in part, on the rationale that although the **GroupWise** reference “teaches a method and a system for automatically extracting contact information from a data store by scanning any of a plurality of file types in a data store.” The Office Action then provides examples of the types of files from which **GroupWise** extracts contact information. In particular, the Office Action notes that the **GroupWise** reference is capable of extracting contact information from sent and received email messages, and from both “foreign” and “standard” address books.

However, independent claims 1 and 32, as amended, now both claim that the data store from which files are extracted includes at least one of **word processor files, spreadsheet files, and presentation files**. As noted above, neither the GroupWise nor MAPI references disclose scanning any of these enumerated file types. Further, the **Teare** reference also fails to disclose scanning any of these enumerated file types. Clearly, as discussed above, one advantage over the cited references is that the claimed invention is capable of extracting contact from a much broader range of sources than any of the cited references. Further, these sources provide a resource for extracting contact information that has not been previously tapped by conventional address resolution systems.

Therefore, it can be seen from the preceding discussion that the rejection of independent claim 1 and independent claim 32 under 35 U.S.C. §103(a) fails to meet the requirements of M.P.E.P. Section 706.02(j). In particular, the **GroupWise - Teare**

combination fails to teach all of the elements of the claimed invention. This lack of a prima facie showing of obviousness means that rejected claim 1, and thus dependent claims 2-3, 5-17, and 21-31 are patentable under 35 U.S.C. §103(a). Thus, the Applicant respectfully requests reconsideration of the rejection of claims 1-3, 5-17, 21-31, 32-36 and 21-31 under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 1, which includes the following novel language:

“An electronic contact resolution method, comprising:  
    automatically extracting contact information from any of a plurality of file types included in a data store, ***said data store including at least one of word processor files, spreadsheet files, and presentation files;***  
    maintaining a list of at least one contact entry derived from the contact information extracted from the data store;  
    automatically computing a weight for each entry in the list;  
    tracking contact information associated with the contact entry; and  
    automatically resolving contact entries in real time by dynamically providing specific contact entries from the maintained list based on the weight of each entry in the list.” (emphasis added)

Similarly, this lack of a prima facie showing of obviousness means that rejected claim 32, and thus dependent claims 33-36, 38-43 and 45-47 are patentable under 35 U.S.C. §103(a). Thus, the Applicant respectfully requests reconsideration of the rejection of claims 32-36, 38-43 and 45-47 under 35 U.S.C. §103(a). The basis for this patentability is the nonobvious language of independent claim 32, which includes the following novel language:

“A system for automatically generating a dynamic list of entries containing contact information comprising:

a data store comprising electronic files, ***said electronic files including at least one of word processor files, spreadsheet files, and presentation files;***

a scan module that scans any of the electronic files included in the data store;

an extract module that extracts contact information from any of the scanned files;

a populate module that populates the list with the information extracted from the scanned files; and

a weight module that dynamically computes a weight for each entry in the dynamic list." (emphasis added)

### CONCLUSION

In view of the above, it is respectfully submitted that claims 1-3, 5-36 and 38-53 are in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of claims 1-3, 5-17, 21-36 and 38-53, and objection to claims 18-20, and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (805) 278-8855 if the Examiner has any questions or concerns.

Respectfully submitted,



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